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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,116	06/25/2001	Yukio Shikatani	33714	2341

116 7590 03/24/2004

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EXAMINER

AL HASHEMI, SANA A

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,116

Applicant(s)

SHIKATANI, YUKIO

Examiner

Sana Al-Hashemi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

**Claims Status: 1-24 rejected**

### *Specification*

The abstract of the disclosure is objected to because it should be on a separate page. Correction is required. See MPEP § 608.01(b).

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC  
(See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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Claim 5 recites the limitation "AV". There is insufficient antecedent basis for this limitation in the claim. Correction is required.

Claim 22, the term "fir" is misspelled. Correction required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C 102(e) as being anticipated by Stern (US Patent No. 6,366,914).

1. Regarding Claim 1, Stern discloses a storage-based digital broadcast system wherein contents transmitted from sending side are stored on a receiving side when reproduced, characterized in that

the sending side transmits service structure information describing the relational structure between service provided by contents providers and reference information associating the contents with the service described in said service structure information, and that (see column 4, lines 17-38, Stern);

the receiving side uses said received service structure information and reference information to manage the storage of said contents (see column 4, lines 49-60, Stern).

2. Regarding Claim 2, Stern discloses a storage-based broadcast system characterized in that. the sending side transmits said service structure information and reference information before transmission of said contents and that the receiving side receives side receives and stores said service structure information and reference information and uses the information for management of said storage of contents to be received later (see column 4, lines 61-67, column 5, lines 1-4, Stern).

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3. Regarding Claim 3, Stern discloses a storage-based broadcast characterized in that the sending side transmits said information before transmission of said contents and transmits said service structure information after transmission of said content and that the receiving side combines said reference information that has been stored and said service structure information that has been received later and uses the information for management of the storage of said contents (see column 5, lines 5-21, Stern).
4. Regarding Claim 4, Stern discloses a storage-based broadcast system characterized in that said contents contains non- stream format data contents (see column 5, lines 15-21, Stern<sup>1</sup>).
5. Regarding Claim 5, Stern discloses a storage-based broadcast system characterized in that said contents contains stream format (see column 4, lines 40-48, Stern)
6. Regarding Claim 6, Stern discloses a storage-based broadcast system characterized in that said service structure information is transmitted via SI (Service Information)( see column 7, lines 27-32, Stern).
7. Regarding Claim 7, Stern discloses a storage-based broadcast system characterized in that said service structure information is transmitted as said SI by using the ERT (Event Relation Table) (see column 7, lines 33-41, Stern)
8. Regarding Claim 8, Stern discloses a storage-based broadcast system characterized in that the type information and for the meaning of the service structure information and for selecting to operation on the receiving side is appended to said service structure information (see column 8, lines 3-11, Stern).
9. Regarding Claim 9, Stern discloses a storage-based broadcast system characterized in that said reference information is transmitted via SI (see column 7, lines 3-12, Stern).
10. Regarding Claim 10, a storage-based broadcast system characterized in that said reference information is Transmitted as said SI by using a reference descriptor (see column 7, lines 13-20, Stern).

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<sup>1</sup> All video images are MPEG which is a non-format data.

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11. Regarding Claim 11, Stern discloses a storage-based broadcast system characterized in that said receiving said exclusively manages the storage areas of said contents per service (see column 5, lines 38-47, Stern).
12. Regarding Claim 12, Stern discloses a storage-based broadcast system characterized in that said receiving side manages the validity term of stored contents per service (see column 8, lines 22-28, Stern).
13. Regarding Claim 13, Stern discloses a storage-based broadcast system according characterized in that said receiving side manages the value of stored contents per service (see column 8, lines 29-36, Stern).
14. Regarding Claim 14, Stern discloses a storage -based broadcast system characterized in that- said sending side specifies a particular service in said service structure information and that the receiving side performs processing tailored to the contents related to the specified service (see column 8, lines 43-47, Stern).
15. Regarding Claim 15, Stern discloses a storage-based broadcast system characterized in that said receiving specifies a service in said service structure information and stores only the contents related to the specified service (see column 8, lines 37-42, Stern).
16. Regarding Claim 16, Stern discloses a storage-based broadcast system characterized in that said sending side appends an automatic storage flag to contents in said reference information and that the receiving side stores or updates the contents with said automatic storage flag appended (see column 7, lines 42-46, Stern).
17. Regarding Claim 17, a storage-based broadcast system characterized in that sending side appended an automatic storage flag to contents in said reference information and specifies a particular service in said service structure information and that the receiving side automatically stores or updates the content related to the specified service (see column 7, lines 42-49, Stern).
18. Regarding Claim 18, Stern discloses a storage-based broadcast system characterized in that said sending side appended an automatic storage flag to contents in said reference information and that said receiving side specifies a service in said service structure information and automatically stores or update the contents with said

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automatic storage flag appended among the contents related to the specified service (see column 7, lines 50-55,  
Stern).

19. Regarding Claim 19, Stern discloses a storage-based broadcast system characterized in that said automatic storage flag is transmitted via SI (see column 7, lines 56-63, Stern).

20. Regarding Claim 20, Stern discloses a storage-based broadcast system characterized in that an EIT (Event Information table) is used to transmit said automatic storage flag as said SI (see column 6, lines 46-67, Stern).

21. Regarding Claim 21, Stern discloses a storage-based broadcast system characterized in that said sending side specifies the relationship between the same contents in said service structure information and that said receiving side avoids duplicated storage of the same contents based on said service structure information (see column 5, lines 22-31, Stern).

22. Regarding Claims 22, and 23, Stern discloses a storage-based digital broadcast system wherein contents transmitted from a sending side are stored on a receiving side then reproduced, characterized in that said transmitter comprises

Service structure information generating means for generating service structure information representing a relational structure between service provided by contents providers (see column 4, lines 17-28, Stern);

Reference information generating means for generating reference information for associating the contents with the service described in said service structure information (see column 4, lines 28-37, Stern);

Service information adding means said reference information to service information (see column 5, lines 54-56, Stern)and ;

Multiplexing/transmission means for multiplexing service information containing said reference information and said service structure information into contents and transmitting the resulting data (see column 5, lines 15-21, Stern).

23. Regarding Claim 24, a receiver characterized in that said receiver comprises automatic storage management means for managing automatic storage of content in said contents storage means based on the automatic storage flag appended to said service information (see column 8, lines 3-11, Stern).

### *Points of Contact*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to: Sana Al-Hashemi whose telephone number is (703) 305-4881. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436. Any response to this office action should be mailed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Or telefax at phone number (703) 872-9306. For formal or draft communications, please label "PROPOSED" or "DRAFT". Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

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March 16, 2004

  
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